



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,640	02/07/2001	Babak Nemati		4426

7590 10/16/2003

Suzannah K Sundby
Jacobson Holman PLLC
400 Seventh Street NW
Washington, DC 20004-2201

EXAMINER

HAYES, MICHAEL J

ART UNIT	PAPER NUMBER
----------	--------------

3763

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/777,640

Applicant(s)

NEMATI, BABAK

Examiner

Michael J Hayes

Art Unit

3763

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


Michael J Hayes
Primary Examiner
Art Unit: 3763

Continuation of 2. NOTE: Applicant's proposed amendments to claim 37 requires further search and/or consideration. The new limitations of porative means with minimal damage must be at least be given further consideration, and may result in a further search.

Some notes regarding the proposed amendment: with porative means for bypassing recited in independent claim 37, the dependent limitations of abrading, acoustic pressure, optical pressure, temperature gradient, concentration gradient, tissue stripping, and laser ablation do not appear to fall within Applicant's definition of porative bypassing means (See claim 70 and Applicant's specification pg. 19, 2nd paragraph). It is not clear whether Applicant's recitation of "delivery means" in section (c) refers to means for delivering agent or means for delivering light.

Applicant argues that Martinez does not show bypassing barrier with minimal tissue damage. Applicant points out that Martinez must make an incision, but Applicant's porative means also includes abrading (claim 56) and tissue stripping (claim 63). Applicant has not explicitly defined "minimal tissue damage" in the original specification which would allow him to rely on a special definition. The phrase is not adequately defined to establish the metes and bounds of the invention.

Applicant's declaration argues against the modification of the invention of Chan as one device as opposed to two separate devices. Applicant has not recited any structural limitation that relates the combination of the two devices. Combining two separate elements into one element is an obvious modification. See *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Applicant's declaration concerning the use of the claimed apparatus are relevant to a method of using the apparatus. The apparatus claims read on the prior art because the prior art is capable of performing the recited functions.